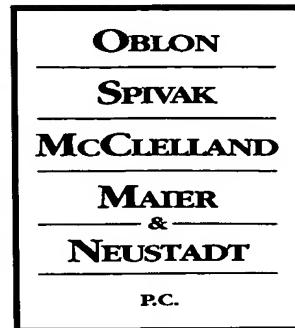




Docket No.: 240373US2



ATTORNEYS AT LAW

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

RE: Application Serial No.: 10/619,431
Applicants: Motoi ASHIDA, et al.
Filing Date: July 16, 2003
For: SEMICONDUCTOR DEVICE AND METHOD OF
MANUFACTURING THE SAME
Group Art Unit: 2815
Examiner: E. Wojciechowicz

SIR:

Attached hereto for filing are the following papers:

RESPONSE TO RESTRICTION REQUIREMENT

Our check in the amount of _____ is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
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DOCKET NO: 240373US2



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
MOTOI ASHIDA, ET AL. : EXAMINER: E. WOJCIECHOWICZ
SERIAL NO: 10/619,431 :
FILED: JULY 16, 2003 : GROUP ART UNIT: 2815
FOR: SEMICONDUCTOR DEVICE AND :
METHOD OF MANUFACTURING THE
SAME

RESPONSE TO RESTRICTION REQUIREMENT

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

This communication is in response to the Official Action dated June 16, 2004.

REMARKS

In response to the restriction requirement stated in the outstanding Official Action, Applicants provisionally elect, with traverse, Group I, Claims 1-4 for further examination on the merits in the present application.

Applicants respectfully traverse the Restriction requirement for several reasons.

First, the outstanding Official Action bases the restriction on the finding that "In the instant case the device of group I can be made by alternative etching steps," but fails to state other differences by which it can be evaluated whether in fact the alternative apparatus is -- materially different--. Lacking such additional information, it is respectfully submitted the PTO clearly has not carried forward its burden of proof to establish distinctness.

Further, MPEP § 803 states:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

The claims of the present invention would appear to be part of an overlapping search area.¹

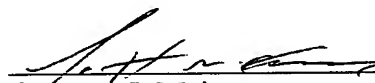
Accordingly, Applicants also respectfully traverse the outstanding Election requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner.

Respectfully submitted,
OBLON, SPIVAK, McCLELLAND,
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¹ To do justice to either identified group of claims, it is respectfully submitted that it would be necessary to search in both Classes and subclasses identified in paragraph 1 at page 2 of the outstanding Official Action.